

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte KOUJI HARA and RYOICHI KURIHARA

---

Appeal No. 1997-4424  
Application 08/184,070

---

ON BRIEF

---

Before JERRY SMITH, FLEMING and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the Examiner in order to clarify his position in regard to the subject matter for this appeal as follows.

This is a Reissue application and involves some claims (for example, claim 1) which remain unchanged from the already patented claims. Now, these same claims are being rejected in

Appeal No. 1997-4424  
Application 08/184,070

the final rejection and at least one of the references relied on

in the instant final rejection is of record in the patented application from which this reissue is being sought. A clarification is in order why the already patented claims are now being rejected.

Besides, there are inconsistencies in the record. For example, the claims on appeal (claims attached as appendix to the (substituted) brief) contain certain claims which are not consistent with the corresponding claims which were amended by the preliminary amendment [paper no. 7] filed with the reissue application, see claim 2 as an example.

Further, the Examiner has given in the answer [pages 8 and 9] a rejection of claims 26 to 29. In the record of the reissue file, however, these claims had been canceled, see the entered amendment after the final rejection [paper no. 19]. Also, the Examiner has missed noting that the phrase "means for receiving and operating" in claim 21 is not found in the independent claim 15 on which claim 21 depends.

Also, starting on page 3 of the answer and bridging over to page 4, the examiner has made some remarks, namely,

Appeal No. 1997-4424  
Application 08/184,070

"[t]here  
is ...". It is unclear whether this is supposed to be a  
rejection, and if so, what the statutory basis for this  
rejection is.

Moreover, the Examiner has indulged in a lengthy  
discussion of the rejection of claims 1 to 25 and 51 to 58  
under 35 U.S.C.

§ 112, first and second paragraphs [answer, pages 4 to 10].  
The Examiner also brings in the sixth paragraph of 35 U.S.C. §  
112 and 35 U.S.C. § 251 as other bases of rejection during the  
body of said discussion. The entire discussion needs to be  
delineated in terms of the grounds of rejection for the first  
paragraph, the second paragraph, the sixth paragraph and 35  
U.S.C. § 251, keeping in mind that this is a reissue  
application and as such requires special attention.

This application by virtue of its "Special" status,  
requires an immediate action, Manual of Patent Examining  
Procedures (MPEP) Section 708.01(7th ed., July 1998). It is  
important that the Board be informed promptly of any action  
affecting the appeal in this case.

REMANDED

Appeal No. 1997-4424  
Application 08/184,070

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
MICHAEL R. FLEMING	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

Fay, Sharpe, Beall, Fagan, Minnich  
& McKee  
104 East Hume Avenue  
Alexandria, VA 22301

PSL/ki